

Serial No. 10/753,737

PATENT
Docket No. 54317-025904REMARKS

Claims 25-32 are pending in the application. Original claims 1-24 and 33-73 have been canceled.

The Office action of July 26, 2005 and art relied by the Examiner have been carefully examined.

I. Claim Rejections under 35 USC §103(a)

In the Action, the Examiner rejects claims 25 and 26 under 35 USC § 103(a) as being unpatentable over U.S. Pat. No. 5,516,114 to Michlin and U.S. Pat. No. 992,233 to Myers. The Applicants respectfully disagree.

1.

a. Claim 25 recites "*each of the first and second lateral portions having a substantially rectangular shape and comprising a slanted leg, each slanted leg comprising a first leg portion and a second leg portion, the first leg portion substantially lying in a first plane, the second leg portion substantially lying on a second plane different from the first plane.*"

In the Action, the Examiner recognizes that such features are not disclosed in Michlin (which shows lateral portions having a substantially semi-circular shape and no legs), stating that those features are disclosed in Myers and that it would have been obvious for the person skilled in the art to 1) modify a substantially semi-circular shape to a rectangular shape and 2) add legs to Michlin's lateral portions to serve as dual clamping means. The Applicants respectfully disagree.

One of the requirements under a 35 USC § 103(a) is motivation to combine one reference with another. The Applicants respectfully submit that there is no motivation to combine Michlin with Myers. The device disclosed in Michlin must necessarily also function as a "jumpertop clipper disk." If Michlin's device would be provided with the legs disclosed in Myers, it would not function as a jump-flighting device anymore. This is also clear from the specification in Michlin, which teaches against providing the lateral portions with legs. See, for example, column

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3, line 66 through column 4, line 6 of Michlin. The two faces of disk 10 in Michlin can only contain recessed or centrally depressed areas but have to be generally flat and substantially parallel. In other words, while adding legs to Michlin's device could, in principle, allow Michlin's device to serve as dual clamping means, it would completely defeat the main purpose in Michlin, i.e. serving as a jumpertop clipper disk. With added legs, the jumping trajectory of Michlin's disk would be far from smooth and would, therefore, not be considered by the person skilled in the art.

Moreover, motivation to combine is also absent when the person skilled in the art starts from Myers. Myers is directed to tag holding clips, as also explained at lines 9-15 of Myers. Why would the person skilled in the art be motivated to combine the tag holding clip with the clipper disk of Michlin? Tag holding is not mentioned among the many uses disclosed in Michlin.

b. Claim 25 also recites "*the second leg portion ending with a hollow section.*"

In the Action, the Examiner is apparently of the opinion that a hollow section is disclosed in Myers. The Applicants assume that the Examiner is referring to the hollow space shown to the immediate left of projection 3 in Figure 3 of Myers. However, that hollow space is formed between the projections 3 and the lower portion 4 of Myers. In Myers, each projection 3 does not "end with a hollow section," it just forms a hollow space with the help of portion 4. In other words, if an element "*end[s] with a hollow section,*" such hollow section is part of that element. In sharp contrast, the hollow space shown in Myers is neither part of the lower portion 4 nor part of the projection 3, it is just formed between the lower portion 4 and each projection 3.

c. Claim 25 further recites "*the central portion being a bent central portion*" (emphasis added).

According to the Examiner, such feature is disclosed in Michlin. The Applicants respectfully but strongly disagree. While the portion of Fig. 1b of Myers (indicated by the Examiner as 'central portion') may be bendable, such portion is not "bent." Otherwise, Michlin's disk would not be able to be used as a jumpertop clipper disk as shown in Figs. 2a-2d and 3a-3d of Michlin.

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d. Claim 25 also recites “*each of the first and second lateral portions comprising a first corner substantially facing the central portion.*”

The Examiner addresses this feature at page 4 of the Action (‘As per claim 25’ subsection), where the Examiner makes reference to a ‘figure below’ which is not present in the Action. Therefore, clarification is respectfully requested. Should the Examiner be still of the opinion that the 103(a) rejection of claim 25 is to be maintained, the clarification requested by Applicant in the present paragraph should be presented in a further non-final Action, in view of the fact that the Figure, which should have helped both the Examiner in making her assertion that the above feature is disclosed in Michlin and the Applicant in interpreting the Examiner’s statement, is missing.

e. Moreover, claim 25 recites that the “*bent central portion [has] . . . a first slanted edge and a second slanted edge.*”

The Examiner is of the opinion that elements 13 in Michlin represent those edges. However, Michlin identifies elements 13 as holes (see Michlin, column 3, line 46), not as “edges.” How can a hole be an edge? Additionally, how can holes 13 be part of the purported “central portion” of Figure 1b in Michlin if the “central portion” is in the middle of Michlin’s disk? Apparently, the Examiner is ‘expanding’ Michlin’s so-called “central portion” to also comprise holes 13. However, if this were the case, how can the portions encompassing the so-called “central portion” be still “lateral portions?” They would become “internal portions,” not “lateral portions.” It is clear that the Examiner is stretching Michlin’s disclosure to an extent that even Mr. Michlin himself would never have suspected present in his device. With all due respect, the Examiner is evidently impermissibly using the Applicants’ claim language as a roadmap, instead of objectively trying to analyze Michlin.

Therefore, the Applicant submits that claim 25 is patentable over Michlin and Myers, together with claims 26-32, by virtue of their dependency on claim 25.

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2. In the Action, the Examiner rejects claims 29 and 30 under 35 USC § 103(a), as being unpatentable over Michlin and Myers, in view of JP2001-015244. The Applicants respectfully disagree.

Claim 29 recites "heat treating the bent cut annealed material." The Applicant has not been able to find where, in JP2001-015244 this feature can be found. It should be noted that, in the abstract of JP2001-015244 the bending process is the last step shown.

Therefore, the Applicant submits that claim 29 is patentable over JP2001-015244, together with claim 30, at least by virtue of its dependency on claim 29. Further, claim 30 is also patentable because the combination of Michlin and Myers does not contain the features of claim 25, as also stated above by Applicant. Still further, it is not clear to Applicant how the device shown in Michlin can be obtained by the process shown in JP2001-015244. In particular, while JP2001-015244 shows a mandatory bending process, as also noted by the Examiner, Michlin does not show bent parts. The device of Michlin can be obtained through simple cutting operations, thus being completely unsuitable for a process like the one shown in JP2001-015244.

II. Allowable claims

In the Action, the Examiner states that claims 27 and 28 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicants have amended claims 27 and 28 to put them in an independent form and agree with the Examiner that amended claims 27 and 28 are allowable.

* * *

In view of the above, it is submitted that this application is now in good order for allowance, and such early action is respectfully requested. Should matters remain that the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney at (310) 586-7703.

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This response is being timely filed and no extension fee is believed due. The Commissioner is in any case hereby authorized to charge any extension fees or any other required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number 54317-025904 when charging any payments or credits in connection with this application.

Respectfully submitted,


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Date: October 21, 2005

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LA-PS1368226v01